

## **REMARKS**

### **I. Introduction**

Claims 10 and 13 to 22 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 10, 13 to 17 and 19 to 22 Under 35 U.S.C. § 102(e)**

Claims 10, 13 to 17 and 19 to 22 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,877,957 ("Bennett"). It is respectfully submitted that Bennett does not anticipate the present claims for the following reasons.

Claim 10 relates to a programmable controller, a display screen including a menu-assisted user interface, an operator unit including a button, the button capable of being switched to an active mode using a programmable function, at least one signal input terminal, at least one signal output terminal and a housing. Claim 10 recites that the processing unit, the display screen, the operator unit, the at least one signal input terminal and the at least one signal output terminal are disposed in the housing. Claim 10 further recites that the at least one signal input terminal is configured to receive the at least one input signal. Claim 10 further recites that a switching function of the controller is programmable in the programmed switching sequence according to predetermined functions using the menu-assisted user interface. Claim 10 further recites that the programmable controller includes a processing unit programmed to affect a switching sequence between, one of at least one input signal and at least one simulated input signal, and at least one output signal. Claim 10 further recites that an operation of the button in the active mode is configured to generate the at least one simulated input signal and to affect the switching sequence of the switching function between the at least one simulated input signal and the at least one output signal.

Claim 20 relates to a programmable controller including a processing unit, a display screen, an operator unit including a button switchable to an active button in accordance with a programmable function, at least one signal input terminal, at least one signal output terminal, a common housing and an arrangement configured to program switching functions on the basis of predetermined function in accordance with a menu-assisted user interface on the display screen. Claim 20 recites that at least one signal input terminal is configured to receive the at least one input signal. Claim 20 further recites that the processing unit, the display screen, the operator unit, the at least one signal input terminal

and the at least one signal output terminal are accommodated in the common housing. Claim 20 further recites that the processing unit is programmed to affect a switching sequence between, one of at least one input signal and at least one simulated input signal, and at least one output signal. Claim 20 further recites that the switching sequence of the switching function is dependent on operation of the button in the active mode to affect the switching sequence of the switching function between the at least one simulated input signal, generated by operation of the button in the active mode, and the at least one output signal.

Claim 21 relates to a programmable controller including a processing means, a display means, an operating means including a button switchable to an active button in accordance with a programmable function, at least one signal input terminal, at least one signal output terminal, a common housing and means for programming switching functions on the basis of a predetermined function in accordance with a menu-assisted user interface on the display means. Claim 21 recites that at least one signal input terminal is configured to receive the at least one input signal. Claim 21 further recites that the processing means, the display means, the operating means, the at least one signal input terminal and the at least one signal output terminal are accommodated in the common housing. Claim 21 further recites that the processing means is programmed to affect a switching sequence between, one of the at least one input signal and the at least one simulated input signal, and at least one output signal. Claim 21 further recites that the switching sequence of the switching function is dependent on operation of the button in the active mode to affect the switching sequence of the switching function between the at least one simulated input signal, generated by operation of the button in the active mode, and the at least one output signal.

Claim 22 relates to a method for directing current by a programmable controller. Claim 22 recites that the programmable controller includes a processing unit, a display screen, at least one signal input terminal, at least one signal output terminal, a common housing and an arrangement configured to program switching functions on the basis of a predetermined function in accordance with a menu-assisted user interface including a button on the display screen. Claim 22 further recites that a sequence of a switching function is dependent on operation of the button. Claim 22 further recites that the processing unit, the display screen, the signal input terminal and the signal output terminal are accommodated in the common housing. Claim 22 further recites the step of entering a program into the processing unit including switching functions configured to control current flow between the at least one input terminal and the at least one output terminal. Claim 22 further recites the

step of operating the button in an active mode so as to generate at least one simulated input signal and so as to affect the switching sequence of the switching function between the at least one simulated input signal and the at least one output signal.

Claims 10 and 20 to 22 have been amended herein without prejudice to recite that the output terminal is separate from the input terminal. Support for this amendment may be found, for example, in Figure 1 and p. 3, lines 20 to 21.

Bennett purportedly relates to an automation system for programming appliances having programmable controllers, programmable devices and trigger devices that are stated to communicate over a communication link 16. The user is stated to program the programmable devices in the following manner. First, the programmable controller is stated to be placed in its training mode, by pressing a train button 18. See col. 4, lines 50 to 54. Next, the trigger device is activated to generate a trigger signal, *i.e.*, the user activates whatever device he or she wants to be able to trigger a response from the programmable controller. For example, the trigger event may be generated by an environmental sensor coupled to a communication link 16 or the opening or closing of a door, *i.e.*, the user may want the opening or closing of a door to trigger, for example, the lighting of a lamp. See col. 5, lines 44 to 48. The trigger event is stated to be the first detected signal by the programmable controller 12 after it has been put in training mode. See col. 5, lines 59 to 62. The next step involves placing select programmable devices in their programmed state, *i.e.*, telling the controller how the user wants it to respond upon receipt of the trigger signal. Abstract. For example, the user may turn on a lamp. See col. 5, lines 25 to 26. After all of the desired programmable devices have been put in their programmed states, the user takes the programmable controller out of its training mode. When the programmable controller is out of its training mode, it monitors the communication link for the trigger event. Upon detecting the trigger event, the programmable controller sends messages to the selected programmable devices instructing them to go to their programmed state.

Nowhere does Bennet disclose, or even suggest, that in an active mode of the device, *e.g.*, during the running of a program with switching activated (see p.2, lines 22 to 23), operation of a button affects or changes the switching sequence of the programmable controller, as recited in claims 10, 20 and 21. The Office Action states that Bennett describes using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp, and therefore, that "pressing the button simulates the input signal of turning on a lamp and affects the switching sequence of the switching function

between the simulated input signal and the output signal (i.e., turns on another lamp).” See Office Action at p. 7 (emphasis added).

Applicant respectfully submits that the Examiner is mistaking the word “affects” with “effects.” The Office Action seems to allege that once the controller is programmed and operational, *i.e.*, in the active state, pressing a programmed button, for example, results in or effects the turning on or off of another appliance, for example. However, the pressing of the button does not “affect” or change the switching sequence of the switching function, as recited in the claims, which was previously set during the training mode. Rather, as indicated above, pressing of the button results only in the turning on or off of a programmed device leaving the underlying switching sequence of the switching function intact and unchanged. Nor does the activation of any button in the training mode meet the above limitation, which requires that the pressing of the button occur in the active state. The training mode is not the active state because as the Office Action admits on p. 7 “placing the system in ‘training mode’ pauses/interrupts the switching function already in place and activate.”

More specifically, nowhere does Bennett disclose, or even suggest, an operation of the button in the active mode is configured to generate the at least one simulated input signal and to affect the switching sequence of the switching function between the at least one simulated input signal and the at least one output signal, as recited in claim 10. Further, nowhere does Bennett disclose, or even suggest, the switching sequence of the switching function is dependent on operation of the button in the active mode to affect the switching sequence of the switching function between the at least one simulated input signal, generated by operation of the button in the active mode, and the at least one output signal, as recited in claims 20 and 21. Further, nowhere does Bennett disclose, or even suggest, operating the button in an active mode so as to generate at least one simulated input signal and so as to affect the switching sequence of the switching function between the at least one simulated input signal and the at least one output signal, as recited in claim 22.

Bennett states that communication link 16 may include home power lines, RF transmissions, messages over dedicated wiring, messages sent as data over phone lines and optical signals. See col. 6, lines 22 to 27. Therefore, Bennett does not disclose, or even suggest, at least one signal input terminal configured to receive at least one input signal and at least one signal output terminal separate from the input terminal, as recited in amended claims 10, 20 and 21, and at least one signal input terminal and at least one signal output terminal separate from the input terminal, as recited in amended claim 22. As indicated

above, Bennett states that the programmable and trigger devices communicate over a single communication link 16. Nowhere does Bennett disclose, or even suggest, separate input and output terminals, as recited in amended claims 10 and 20 to 22.

The Office Action references col. 6, lines 22 to 27 and alleges that Bennett “discloses input signals and output signals wherein the connections may be over dedicated wiring, which inherently is linked to terminals.” Applicant respectfully submits that just because the input and output signals are over dedicated wiring does not mean that they have separate terminals.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Nowhere does the Office Action set forth any technical reasoning to support its conclusion that input and output signals, regardless of whether they travel over a single communication link or over dedicated wiring, necessarily have separate terminals.

Therefore, for all the foregoing reasons, Applicant respectfully submits that Bennett does not disclose, or even suggest, all of the limitations of claims 10 and 20 to 22.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Bennett does not disclose, or even suggest, all of the limitations of claims 10 and 20 to 22. It is therefore respectfully submitted that Bennett does not anticipate claims 10 and 20 to 22.

As for claims 13 to 17 and 19, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, Applicant respectfully submits that

Bennett does not anticipate these dependent claims for at least the same reasons provided above in support of the patentability of claim 10.

In summary, Applicant respectfully submits that Bennett does not anticipate claims 10, 13 to 17 and 19 to 22. Withdrawal of this rejection is therefore respectfully requested.

### **III. Rejection of Claim 18 Under 35 U.S.C. § 103(a)**

Claim 18 was rejected under 35 U.S.C. § 103 (a) as unpatentable over the combination of Bennett and U.S. Patent No. 5,997,167 ("Crater et al."). Applicant respectfully submits that the combination of Bennett and Crater et al. does not render unpatentable claim 18 for the following reasons.

Claim 18 depends from claim 10. As indicated above, Bennett does not disclose, or even suggest, that an operation of a button in an active mode is usable to generate at least one simulated input signal and to affect a switching sequence of a switching function between at least one simulated input signal and at least one output signal, as recited in claim 10. Crater et al. purportedly relate to a programmable controller including diagnostic and simulation facilities. Applicant respectfully submits that Crater et al. do not remedy the above-noted deficiencies of Bennett. Crater et al. are not relied upon for remedying the above-noted deficiencies of Bennett. Therefore, it is respectfully submitted that the combination of Bennett and Crater et al. does not disclose all of the limitations of claim 18, which depends from claim 10.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, the combination of Bennett and Crater et al. fails to disclose, or even suggest, all of the limitations of claim 10, from which claim 18 depends. It

is therefore respectfully submitted that the combination of Bennett and Crater et al. does not render unpatentable claim 18. Therefore, withdrawal of this rejection is respectfully requested.

**IV. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: January 3, 2005

By:

Richard L. Mayer  
Reg. No. 22,490

One Broadway  
New York, New York 10004  
(212) 425-7200  
CUSTOMER NO. 26646